

ESTTA Tracking number: **ESTTA590684**

Filing date: **03/04/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85709886
Applicant	PPR Corazon, LLC
Applied for Mark	VITA FITNESS CORAZON
Correspondence Address	Matthew H. Swyers The Trademark Company 344 Maple Avenue WestPMB 151 Vienna, VA 22180 UNITED STATES info@thetrademarkcompany.com
Submission	Appeal Brief
Attachments	Brief of the Applicant.pdf(189760 bytes )
Filer's Name	Matthew Swyers
Filer's e-mail	mswyers@TheTrademarkCompany.com
Signature	/Matthew H. Swyers/
Date	03/04/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	
PPR Corazon, LLC	:	
	:	
Serial No.: 85/709,886	:	Examining Attorney: Kim L. Parks
	:	
Filed: August 22, 2012	:	Law Office: 112
	:	
Mark: VITA FITNESS CORAZON	:	
	:	

---

**BRIEF OF THE APPLICANT**

## TABLE OF CONTENTS

	Page No.s
Table of Authorities.....	3
I. Introduction.....	4
II. Statement of the Case.....	4
III. Argument.....	4
A. The Cited Registration is Limited to a Narrow Scope of Protection.....	6
B. Distinctions as Evidenced by Third-Party Registrations for LIFE and FITNESS are Sufficient to Permit the Application to Register.....	8
IV. Conclusion.....	12

## TABLE OF AUTHORITIES

### CASES:

First Savings Bank F.S.B. v. First Bank System Inc., 101 F.3d at 645, 40 USPQ2d 1865, 1870 (10 <sup>th</sup> Cir. 1996).....	6, 7
Giersch v. Scripps Networks, Inc., 90 USPQ2d 1020 (TTAB 2009).....	7
In re Box Solutions Corp., 79 USPQ2d 1953 (TTAB 2006).....	7
In re Cent. Soya Co., 220 USPQ 914, 916 (TTAB 1984).....	8
In re Dixie Restaurants Inc., 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).....	5
In re E.I. du Pont DeNemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).....	5, 7
<i>Luigino's Inc. v. Stouffer Corp.</i> , 50 USPQ2d 1047.....	6
Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc., 875 F.2d 1026, 10 USPQ2d 1961 (2d Cir. 1989).....	5
Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).....	6, 7
Universal Money Centers, Inc. v. American Tel. & Tel. Co., 22 F.3d 1527, 30 USPQ2d 1930 (10 <sup>th</sup> Cir. 1994).....	5

### RULES:

TBMP § 1208.04 .....	7
----------------------	---

## **I. INTRODUCTION**

COMES NOW the Applicant PPR Corazon, LLC (hereinafter “Applicant”), by counsel Matthew H. Swyers, Esq., The Trademark Company, PLLC, and submits the instant Brief of the Applicant in support of Applicant’s argument that its mark should be registered on the Principal Register for the U.S. Patent and Trademark Office.

## **II. STATEMENT OF THE CASE**

On or about August 22, 2012 the Applicant applied to register the standard character trademark VITA FITNESS CORAZON with the U.S. Patent and Trademark office in connection with multiple services in Class 41 all dealing with fitness and the provision of fitness-related services. The application received Serial No. 85/709,886. With its inserted translation, the mark, under the doctrine of foreign equivalents, translates into LIFE FITNESS HEART.

On December 18, 2012 the office refused registration of the instant mark on the grounds that, if registered, the mark would create a likelihood of confusion with the registered marks in Reg. Nos. 1977950 and 3299375.

On or about June 18, 2013, Applicant, by counsel, submitted its arguments in favor of registration. Thereafter, the office, by action dated July 16, 2013, withdrew the refusal based upon Reg. No. 3299375 but held on the refusal based upon Reg. No. 1977950. The instant appeal now timely follows.

## **III. ARGUMENT IN SUPPORT OF REGISTRATION**

A determination of likelihood of confusion between marks is determined on a case-specific basis. In re Dixie Restaurants Inc., 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The examining attorney is to apply each of the applicable factors set out in In re E.I. du Pont

DeNemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant DuPont factors are:

- (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) the similarity or dissimilarity and nature of the services as described in an application or registration or in connection with which a prior mark is in use;
- (3) the similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) the conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing;
- (5) the number and nature of similar marks in use on similar services; and
- (6) the absence of actual confusion as between the marks and the length of time in which the marks have co-existed without actual confusion occurring.

See *id.*

The examining attorney is required to look to the overall impression created by the marks, rather than merely comparing individual features. *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1029, 10 USPQ2d 1961 (2d Cir. 1989). In this respect, the examining attorney must determine whether the total effect conveyed by the marks is confusingly similar, not simply whether the marks sound alike or look alike. *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1870 (10<sup>th</sup> Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still must be considered as a whole)(citing *Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1531, 30 USPQ2d 1930 (10th Cir. 1994)).

Even the use of identical dominant words or terms does not automatically mean that two marks are similar. In *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442 (8th Cir. 1987), the court held that “Oatmeal Raisin Crisp” and “Apple Raisin Crisp” are not

confusingly similar as trademarks. Also, in *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1874 (10<sup>th</sup> Cir. 1996), marks for “FirstBank” and for “First Bank Kansas” were found not to be confusingly similar. Further, in *Luigino’s Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark “Lean Cuisine” was not confusingly similar to “Michelina’s Lean ‘N Tasty” even though both marks use the word “Lean” and are in the same class of services, namely, low-fat frozen food.

In the instant case, the services of the parties, in part, directly overlap. As such, it cannot be said that they are dissimilar. Moreover, as there are no limitations as to the channels of trade or presumed marketing channels of the goods as identified in the application and registrations, the services of the Applicant are presumed to travel in the same channels of trade and are further presumed to be marketed in the same manner of those services identified in the cited registrations.

However, even with several of the du Pont factors favoring refusal of the mark, Applicant maintains its position that his trademark should be entitled to registration based upon the dissimilarities in the marks at issue when viewed in consideration of the limited scope of protection which should be afforded to the registrant by virtue of the highly suggestive if not descriptive nature of the cited registrations.

#### **A. The Cited Registration is Limited to a Narrow Scope of Protection**

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1026 (TTAB 2009); *In re Box*

Solutions Corp., 79 USPQ2d 1953, 1957-58 (TTAB 2006); In re Cent. Soya Co., 220 USPQ 914, 916 (TTAB 1984).

In the instant case, the Examining Attorney has cited the following mark as blocking the instant application:

LIFE FITNESS, Reg. No. 1,977,950, for “health club services” in International Class 41.

Dictionary.com<sup>1</sup> defines the term “LIFE” as follows:

**Adjective**

**26.**

for or lasting a lifetime; lifelong: a life membership in a club; life imprisonment.

**27.**

of or pertaining to animate existence: the life force; life functions.

**28.**

working from nature or using a living model: a life drawing; a life class.

The term “FITNESS” is defined by Dictionary.com<sup>2</sup> as follows:

**noun**

**1.**

health.

As set forth above, the term LIFE is defined as lasting for a lifetime or lifelong. The term FITNESS is simply defined as health. As such, examining the cited marks as a whole in conjunction with their recited services we discover that they use LIFE FITNESS having an equivalent meaning of lifetime fitness or health for health club services.

In this regard, it is submitted that the cited registration are highly suggestive if not merely descriptive of the recited services for which it is registered and, as a result, is only entitled to a very narrow scope of protection under the Act. See Palm Bay Imps., Inc., 396 F.3d at 1373, 73 USPQ2d at 1693.

---

<sup>1</sup> It is requested that the Board take judicial notice of this definition pursuant to § 1208.04 of the TBMP.

<sup>2</sup> It is requested that the Board take judicial notice of this definition pursuant to § 1208.04 of the TBMP.

**B. Distinctions as Evidenced by Third-Party Registrations for LIFE and FITNESS are Sufficient to Permit the Application to Register**

Applicant previously submitted evidence of multiple other registrations using the same or similar terms in relation to similar services co-existing on the Principal Register. Generally, the existence of third-party registrations cannot justify the registration of another mark that is so similar to a previously registered mark as to create a likelihood of confusion, or to cause mistake, or to deceive. E.g., *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009).

However, third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. See, e.g., *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012)(emphasis added); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eaglemotive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988); *Plus Prods. v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983).

There can be no doubt that both the Applicant's mark and that of the registrant contain the terms, or translation equivalents thereto, LIFE FITNESS in connection with health-related services in International Class 41. However, so too do the 12 other registrations made of record by Applicant's earlier submission. The marks are as follows:

LIFE TIME FITNESS, U.S. Reg. No. 2,140,172, owned by Life Time Fitness, Inc., used in connection with "physical fitness instruction and health club services" in International Class 41, See Exhibit 4 to Applicant's Request to Reconsider dated November 21, 2013 (hereinafter "Request to Reconsider");

LIFELONG FITNESS, U.S. Reg. No. 3,553,333, owned by Fifty Plus Fitness Association, used in connection with "Providing assistance, personal training and physical fitness consultation to individuals to help them make physical fitness, strength, conditioning, and exercise improvement in their daily living; Organizing and conducting an annual foot-race; Educational services, namely, developing,

arranging, and conducting educational conferences in the field of physical fitness and wellness” in International Class 41; See Exhibit 6 to Request to Reconsider;

PRAIRIELIFE FITNESS, U.S. Reg. No. 3,323,326, owned by Life Centers, Inc., used in connection with “Providing fitness and exercise facilities” in International Class 41, See Exhibit 7 to Request to Reconsider;

ONELIFE FITNESS, U.S. Reg. No. 3,920,734, owned by OneLife Fitness, LLC, used in connection with “Providing fitness and exercise facilities; personal training services, namely, strength and conditioning training at the foregoing fitness and exercise facility” in International Class 41, See Exhibit 9 to Request to Reconsider;

VIDA FITNESS, U.S. Reg. No. 3,299,375, owned by Urban Adventures Companies, Inc, used in connection with “Physical fitness instruction; providing fitness and exercise facilities” in International Class 41, See Exhibit 10 to Request to Reconsider;

LIFE CHANGE FITNESS, U.S. Reg. No. 3,964,908, owned by Straight Forward Advice Corporation DBA Life Change Fitness, used in connection with “Personal fitness studio services, namely, working with clients one-on-one to help them achieve their specific fitness, weight loss, body fat reduction, muscle gain, and stamina goals through the provision of tailored workouts” in International Class 41, See Exhibit 11 to Request to Reconsider;

LIFEWORX LIFEWORX FITNESS, U.S. Reg. No. 4,002,243, owned by Lifeworx Fitness, LLC, used in connection with “Personal or group physical fitness training services for optimum health and fitness” in International Class 41, See Exhibit 12 to Request to Reconsider;

FITNESS FOR KIDS FITNESS FOR LIFE!, U.S. Reg. No. 3,455,070, owned by Fitness for Kids, Inc., used in connection with “Summer camps; Physical fitness conditioning classes; Physical fitness consultation; Physical fitness instruction; Contests and incentive award programs to encourage students and organization members to set up and achieve goals in academics, attendance, citizenship and conduct” in International Class 41, See Exhibit 14 to Request to Reconsider;

IT'S NOT FITNESS. IT'S LIFE., U.S. Reg. No. 3,384,480, owned by Equinox Holdings, Inc., used in connection with “Physical fitness conditioning classes; providing fitness and exercise facilities; personal training services, namely, strength and conditioning training; health club services, namely, providing instruction and equipment in the field of physical exercise; educational services, namely, conducting courses in the field of health and wellness” in International Class 41, See Exhibit 15 to Request to Reconsider;

B2B FITNESS BE FIT BE LIFE, U.S. Reg. No. 3,322,291, owned by B2B Fitness LLC, used in connection with “Personal fitness training.” in International Class 41; See Exhibit 16 to Request to Reconsider;

SUPREME FITNESS LIFE IN MOTION S, U.S. Reg. No. 3,391,943, owned by Muhammad, Andrew, used in connection with “Health club services, namely, providing instruction and equipment in the field of physical exercise; Personal training services, namely, strength and conditioning training” in International Class 41, See Exhibit 17 to Request to Reconsider; and

FITNESS 4 LIFE, U.S. Reg. No. 3,654,060, owned by TNT "Fit 4 Life" Weight Loss Program, LLC, used in connection with “Personal trainer services; Personal training services, namely, strength and conditioning training; Personal training services, namely, strength and conditioning training and speed training; Physical fitness training services; Providing a website featuring online sports training and training advice and the recording of training and workouts; Providing assistance, personal training and physical fitness consultation to corporate clients to help their employees make physical fitness, strength, conditioning, and exercise alterations in their daily living; Providing assistance, personal training and physical fitness consultation to individuals to help them make physical fitness, strength, conditioning, and exercise improvement in their daily living; Providing information in the field of exercise training; Sports training services” in International Class 41, See Exhibit 18 to Request to Reconsider.

In sum, the evidence of record demonstrates that there are no less than 12 registered federal trademarks which use, in standard character format or in design, the terms LIFE and FITNESS, or the translation equivalents thereof, in connection with health-related services in International Class 41.

Examining the marks as a whole it is easy to determine that which they share in common: the terms LIFE and FITNESS. However, of greater interest is what they lack in common: any other terms or designs which overlap with one another. In short, although all 12 registered marks, and actually 13 if you count the cited registration, contain the terms LIFE and FITNESS they each contain other elements that seemingly distinguish one from another sufficient to have allowed them to co-exist on the federal register.

Returning to the law on point, third-party registrations are relevant to show that a mark, or a portion of a mark, is so commonly used that the public will look to other elements to distinguish the source of the goods or services. See, e.g., *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eaglemotive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988); *Plus Prods. v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983). It is submitted that the registrations of record demonstrate that this is such an instance and the Board should rely on *In re Hartz Hotel Servs., Inc.* in determining that the applied-for mark would not be likely to cause confusion or mistake with the cited registration.

Specifically, the 12 federal registrations all contain the terms LIFE FITNESS used in connection with health-related services in International Class 41. As such, their respective trade channels and marketing channels are also all presumed to be the same with one another as with the Applicant's and the cited registration. But something has permitted these 12 registered marks to co-exist with one another. It is submitted that that something is the fact that there is ample evidence that consumers will look to other elements in these marks to distinguish between the source of the services provided thereunder. Namely, the office has registered 13 marks with the same element(s), LIFE and FITNESS, in connection with health-related services in International Class 41. There simply must be a recognition under *In re Hartz Hotel Servs., Inc.* that consumers will look to other elements in the respective marks to identify the source of the services. If not, under the logic followed by the Examining Attorney in refusing the instant mark all 12 other registrations set forth herein should have been cited against the registration of the instant mark and not merely the one.

Of course, Applicant is not arguing in favor of the Office citing an additional 12 registrations to block the registration of its mark. Rather, based upon the evidence of record, Applicant asserts that in this instance the evidence of record clearly establishes that the public will look to other elements to distinguish the source of the services as between its and the cited registration as evidenced by the 12 registrations registered in connection with health-related services that also include the words LIFE and FITNESS therein and, in the absence of there being an overlap of the other elements of the respective marks, and there is not, the instant mark should be permitted to register.

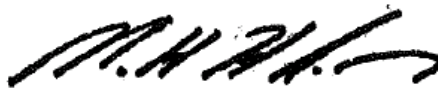
### **CONCLUSION**

In conclusion, based upon the foregoing it is submitted that the du Pont factors addressed herein favor registration of the Applicant's mark.

WHEREFORE it is respectfully requested that the Board reverse the decision of the Examining Attorney, remove as an impediment the cited mark, and order that the mark be approved for publication upon the Principal Register.

Respectfully submitted this 4<sup>th</sup> day of March, 2014.

THE TRADEMARK COMPANY, PLLC



---

Matthew H. Swyers, Esquire  
344 Maple Avenue West, PMB 151  
Vienna, VA 22180  
Tel. (800) 906-8626 x100  
Facsimile (270) 477-4574  
admin@thetrademarkcompany.com